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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,234	01/17/2002	Ulrich Mueller	50512	8185
26474	7590	01/02/2004		
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER VOLLANO, JEAN F	
			ART UNIT 1621	PAPER NUMBER

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/031,234	MUELLER ET AL.	
	Examiner	Art Unit	
	Jean F. Vollano	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The request for an RCE filed 11/17/2003 has been entered. Claims 7-28 are pending.
2. The amendment to the claims removing ITQ-4 and MCN-22 has left the other codes as found at the website given by applicant and they are available to anyone of ordinary skill in the art. The removal of the terms not found on the web site has overcome the 35 USC 112, paragraph 2 rejection and it is withdrawn.
3. Claim 25 has a new proviso that excludes carbon catalysts and therefore the 102(b) rejection as anticipated by Felthouse over claims 25-27 is withdrawn as is the 103(a) on claims 25-28 over Felthouse. However this may be new matter and if it is found to be new matter and removed from the claims then the rejections would be re-instated.
4. The rejection of claims 7-24 under 35 USC 112, first paragraph is maintained for reasons of record.

Applicant argues that the test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter"

The examiner ^{agrees} ~~agrees~~ with that statement however applicant states that they met the requirement through the explicit description of the catalyst and through the discussion of Felthouse in the specification.

In the specification the Felthouse discussion in the specification it only states that the reaction is formed in the "presence of a catalyst system which comprises activated carbon together with microporous acid resistant aluminosilicate..." There is nothing in this discussion which points out that the carbon should not be used in the reaction. Nor is there any implication to that point that the examiner can find in this section of the specification.

The specification does not point out in any section that use of an activated carbon is not favored. It is also noted that the proviso does not state that the catalyst is an activated carbon catalyst, just a carbon catalyst.

The limitation seems to only have been added upon the 102(b) rejection cited by the examiner over Felthouse . The claims are written in an open ended format which does not preclude the use of other catalysts including activated carbon as a catalyst. Just because the zeolites may not contain carbon or in some instances in the literature are used with carbon and activated carbon as a carrier or a cocatalyst for other activities does not mean that carbon catalysts must obviously be excluded in the instant invention . Nor is there any indication in the specification that it is important to the invention to exclude carbon catalyst. Just because specification states that the prior art teaches the combination of carbon and zeolites does not mean that in the instant invention the elimination of the activated carbon is as a required part of the catalytic system . Nor does it show in any part specification that the invention be performed specifically in systems that do not contain activated carbon. It is one thing to state in a claim the line of "consisting of" eliminate other entities and another to pick out a specific entity that is to be eliminated but not mentioned in the specification since it was named in another reference. The question is not did applicant know about the combination of the activated carbon and the

catalyst at the time of invention but did applicant know that the activated carbon should be excluded from the instant invention? There is no support to show that there was possession of this at the time of the instant invention and applicant must be in possession of even a negative limitation (i.e. have the knowledge that the carbon should be avoided in the instant invention). The rejection for the phrase framework type codes is withdrawn since applicant's argument has been persuasive.

5. The 112, paragraph 2 over claims 7-24 are maintained for reasons of record.

In reference to this rejection applicant argues that the term "excluding carbon catalysts" makes the claim unclear and states that in light of the specification it does not. Applicant also states that the exclusion of this type of activated carbon catalysts was discussed in the application on page 1 lines 25-35.

First of all it is noted that the excluded catalyst is not described as an activated carbon catalyst but just a carbon catalyst.

Also the term excluding carbon catalysts seems to be stating as written that the silicates contains carbon catalysts as worded. If the wording is trying to eliminate activated carbon catalysts from the heterogeneous catalysts and not from the silicates it should be worded in a clearer and concise manner specifically pointing out the metes and bounds of what is being claimed as the instant invention. Also is the claim limited to inorganic carbon or organic carbon such as hydrocarbons?

As for the rejection of "having framework type codes" it is withdrawn.

Claim Rejections - 35 USC § 112

Claims 25-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 25 recites the limitation of "excluding carbon catalysts." This limitation was not presented in the original claims as filed. The examiner cannot find support for this limitation in the specification and applicant has not shown support in the specification for this limitation. Applicant is asked to either withdraw the claim language that is new matter or show support for the language

Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.


Claim 25 recites the limitation of "excluding carbon catalysts". This phrase is confusing as to what the metes and bounds of the claims are and what it is being excluded from. As it is worded the exclusion seems to be from silicates which is confusing as to whether the silicates have carbons catalysts as part of there structure. Also if it is trying to be excluded from heterogeneous catalysts then it is unclear what is meant by carbon catalysts since there are organic heterogenous carbon catalysts and inorganic heterogeneous carbon catalysts. Is diamond a carbon catalyst? When is carbon a catalyst?

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Vollano whose telephone number is 703-305-4483. The examiner can normally be reached on Monday-Thursday 6:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Jean F. Vollano
Primary Examiner
Art Unit 1621

December 29, 2003